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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,828	10/29/2001	Yongming Sun	DEX-0247	6752
26259	7590	10/13/2004		
LICATLA & TYRRELL P.C. 66 E. MAIN STREET MARLTON, NJ 08053			EXAMINER LY, CHEYNE D	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/082,828

Applicant(s)

SUN ET AL.

Examiner

Cheyne D Ly

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7 and 8 is/are rejected.
- 7) ☒ Claim(s) 1 and 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/23/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 23, 2004 has been entered.
2. Claims 1-5, 7, and 8, SEQ ID NO: 75, are examined on the merits.

### **OBJECTIONS**

3. The title of the invention is not descriptive because the instant title is directed to compositions and methods while the elected invention is directed to a nucleic acid composition. A new title is required that is clearly indicative of the invention to which the claims are directed.
4. Claim 1 is objected to because of the following informalities: Line 11 recites the symbol “-” above the symbol “,” which has been interpreted as a typographical error. Appropriate correction is required.
5. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **CLAIM REJECTIONS - 35 USC § 102**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1, 3-5, 7, and 8 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Birren et al. (May 2000).

#### **RESPONSE TO ARGUMENT**

8. Applicant has argued that the claim amendment has caused the claimed invention as recited by claims 1, 3-5, 7, and 8 to overcome the instant prior rejection. Applicant's argument has been fully considered and found to be unpersuasive as discussed below.

9. Birren et al. discloses a nucleic acid molecule (Accession Number AC024983) that is at least 85% (Best Local Similarity 97.1%) sequence identity to the nucleic acid molecule of SEQ ID NO. 75. The nucleic acid molecule of Birren et al. comprises a sequence (positions 61465-61546) that would hybridize to the sequence of SEQ ID NO. 75 (positions 1-82) under the stringent conditions defined in the instant specification (page 14, lines 26-28). Applicant discloses as an example of stringent hybridization conditions at 42°C or 68°C (page 15, lines 20-32).

10. It is noted that the cited sequence (AC024983, positions 61465-61546) of Birren et al. has been determined to have 37% GC content and a  $T_m$  of 82.5°C. Therefore, the cited sequence of Birren et al. would hybridize to the sequence of SEQ ID NO. 75 under the stringent hybridization conditions defined in the instant specification. Applicants are to refer to Meinkoth et al. (particularly page 269) for the calculation of thermal melting temperature ( $T_m$ ).

Further, the nucleic acid of Birren et al. is of human genomic DNA in a M13 vector (page 1, lines 7 and 51; and page 2, line 46). It is well known in the art that the M13 vector is propagated in bacterial host cells (Griffiths et al., page 3, lines 8-13), as in instant claims 1, 3-5, 7, and 8.

## **CONCLUSION**

11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

12. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

13. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

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15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

C. Dune Ly  
10/4/04

*Ardin H. Marschel 10/12/04*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER